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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,826	04/12/2001	Kaoru Uchida	Q64083	1952

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/832,826

Applicant(s)

UCHIDA, KAORU

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 17, 22-26, 31, 33, 35-43, 45 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-16, 18-21, 27-30, 32, 34 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010412, 20031211, 20040430  
20050406
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Response to Election filed 11/7/05.

#### ***Election/Restrictions***

2. Applicant's election without traverse of Figure 1 in the reply filed on 11/7/05 is acknowledged. However, the indication of which claims applicant has stated are drawn to Figure 1 appears to be incorrect. The applicant has stated that claims 1-34 and 44-46 are drawn to Figure 1, however the examiner as found that some of the claims are directed to other figures. Figure 7 has the delivery station feature that is not in Figure 1 (Claim 45), Figure 12 has the matching done at the EC server (claims 17, 22 and 31) which is not done in Figure 1 and Figure 15 has the encryption/decryption feature (claims 5-8, 23-26 and 33) which is not shown in Figure 1. Therefore these claims have also been withdrawn from consideration for being directed to a non-elected species, and the claims are as follows:

- a. Claims 1-4, 9-12, 13-16, 18-21, 27-30, 32, 34 and 44 are currently pending for examination.
- b. Claims 5-8, 17, 22-26, 31, 33, 35-43, 45 and 46 are withdrawn from consideration.

#### ***Information Disclosure Statement***

3. The information disclosure statements filed 4/30/04 and 4/12/01 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. They has

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been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

4. Claims 1-46 are objected to because of the following informalities: The claims appear to be a literal translation into English and are replete with grammatical errors. It is suggested that the claims are reviewed and corrected for any grammatical errors. For example (these are examples only, there contain more grammatical errors than what is stated), the phrases “an delivery order”, “to receive delivered said article”, “portable terminal carrying by a delivery person” and “each of said plural personal verifying terminal”. Appropriate correction is required.
5. Claims 13-31 are objected for failure to accomplish the preamble of the claims. The preamble states a “method to deliver” yet there is no delivery step, only a verifying step.
6. Claims 1-46 use an EC server. The applicant has accompanied the term “EC” with its definition in one of the independent claims. However, this must be done where it first appears in each independent claim.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-4, 9-12, 13-16, 18-21, 27-30, 31, 32, and 34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1-4, 13-16 and 32 recite the limitation "the biometric data". There is insufficient antecedent basis for this limitation in the claims. Furthermore, this phrase appears twice in the claim, one for who makes the order and on that receives the order, and it is unclear if this is the same data. The claims have not positively claimed that the biometric data of the recipient has been collected, therefore it is unclear what is actually being matched.

10. Claims 2, 5 and 32 recites the limitation "the destination". There is insufficient antecedent basis for this limitation in the claims.

11. Claims 1-4 and 9-12 recites the limitation "the recipient". There is insufficient antecedent basis for this limitation in the claims.

12. Claims 14-16 recites the limitation "the matched result". There is insufficient antecedent basis for this limitation in the claims.

13. Claim 34 recites the limitation "said pair verified information". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-4, 13-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Danielson et al. (US 2003/0081860).

16. With respect to Claims 1-4 and 13-16 : Danielson discloses a method to verify the recipient of a delivered article and a method to delivery an article to a recipient, comprising the steps of:

c. Storing the biometrics data presented by a person who made a delivery order for an article when the delivery order was made, the biometrics data is stored in a portable terminal carried by a delivery person (Paragraph 0070, Danielson discloses the signature, which is a form of biometric data, is stored for persons who are allowed to accept the delivery).

d. Transmitting the biometrics data presented by said person who made said delivery order to the destination of said article (Paragraph 0070, Danielson discloses the delivery information is downloaded to the portable device, which is used at the destination of the article),

e. Matching, at the destination of the article, the biometrics data presented by said person who made said delivery order with the biometrics data presented by a person who is to receive delivered said article by using said portable terminal at the time the article is delivered, (See abstract, and Paragraph 0071, Danielson discloses matching signatures).

17. With respect to Claims 18-21: Danielson discloses biometrics data is inputted at the time when said article was delivered is stored as verified information for the person who received said article. (See Paragraph 0071, and Figures 17 and 18).

18. Claims 32, 34 and 44 rejected under 35 U.S.C. 102(e) as being anticipated by Van Till et al (6,404,337).

19. With respect to Claims 32 and 44: Van Till discloses the use of a system (computer program operating the system), to deliver an article to a recipient, in which plural ordering terminals, an EC server, and plural person verifying terminals, are connected through a network, (See Figures 1, 9 and 11, Van Till discloses the system to be used for multiple carriers and multiple carriers in Column 1, lines 48-62, therefore the system would have multiple ordering terminals as well as multiple verifying terminals, since they are specific to the customers) wherein:

- f. the plural ordering terminals (Figure 9, Place order using handheld device or computer), comprise:
  - i. an order information inputting section to which a person who makes an order for an article inputs order information (Column 4, lines 47-52 and Column 8, lines 36-62);
  - ii. an ordering side feature extracting section for extracting the biometrics data of the person who the order (Column 5, lines 5-9, and Column 9, lines 25-28, Van Till discloses the customer inputting the signature for verification, which the system turns to a digital signature, which the examiner considers to be biometric data); and
  - iii. a transmitting and receiving section that transmits biometrics data extracted at said ordering side feature extracting section and said order

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information inputted from said order information inputting section to said EC server through said network (Column 5, lines 13-15),

g. the EC server, comprising:

iv. a transmitting destination deciding section that transmits the biometrics data transmitted from the ordering terminal to a person verifying terminal corresponding to said destination in said order information transmitted from said ordering terminal through said network (Column 10, lines 12-41, Step 86 and Figure 9), and

h. the person verifying terminal, comprising:

v. a verifying side feature extracting section for extracting the biometrics data of a person who is to receive delivered said article when said article is delivered (Column 4, lines 32-45);

vi. a feature matching section for matching said biometrics data extracted at said verifying side feature extracting section with said biometrics data transmitted from said EC server, and for showing the matched result of said two biometrics data to an article delivering person (Column 5, lines 19-31 and Column 10, lines 54-64).

20. With respect to Claim 34: Van Till discloses that once the signatures are matched, the tracking information (which includes order information as well as delivery information, therefore the examiner considers to be the pair verified information) to the central operations computer as well as the merchant (Column 6, lines 11-27 and 36-44, and Column 10, line 65 to Column 11, line 6).



*Claim Rejections - 35 USC § 103*

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 9-12 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielson et al. (US 2003/0081860) in view of Uchida (6,751,734).

23. With respect to Claims 9-12 and 27-30: Danielson discloses the use of biometric data, such as signatures, being used for verification of delivery, but fails to disclose the use of the biometric data being a fingerprint. Uchida discloses the use of a hand held device, which collects biometric data such as fingerprints, for verification purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Danielson, to have the biometric data (signature) be a fingerprint, as disclosed by Uchida in order to prevent fraudulent use of a person's identity and to eliminate the possibility of it being stolen. (See Uchida, Column 1)

*Conclusion*

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simms et al. (US 2005/0104716) discloses the use of a system for ordering and scheduling of delivery for an item, Kucharczyk et al. (6,300,873) discloses the use of a locking mechanism, that allows a fingerprint to be used to unlock a storage device, Smithies et al.

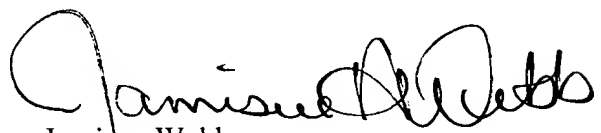
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(5,647,017) discloses the use of electronic signature verification and Kantarjiev et al. (US 6,975,937) discloses the use of a mobile device which verifies a customer for delivery.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 3629